

REMARKS

Remarks to follow are numbered to correspond to the office action.

Please note that the only amendment is to claim 1, where
5 the phrase "from more than [sic] side cross-sections" is amended
to say "from more than two side cross-sections" in order to
correct an earlier typographical error. This amendment does not
impact the substantive examination of this application in any
way, nor does it necessitate additional prior art searches or
10 other action "necessitated by applicant's amendment."

As outlined below, it is applicant's view that the pending
claims, without amendment other than to correct this
typographical error, are fully patentable over the prior art of
record, and that examiner's present 103 rejection cannot be
15 sustained.

Claim Rejections - 35 U.S.C. §103

1-2.

Independent Claim

20 Most of applicant's claims including independent claim 1
are rejected under 35 U.S.C. §103 based on Lillelund in view of
Allen. Applicant respectfully disagrees with this rejection for
the reasons summarized below.

While Lillelund is used as the base reference, it is

helpful first to start with Allen, and then return to Lillelund.

Allen is a beverage mug used for drinking. While Allen contains a gradually-widening wide base not dissimilar to applicant's "bottom" half, Allen clearly omits applicant's "top" half characterized by a gradually-narrowing region especially toward the top of the apparatus. This is with very good reason: as has been pointed out in prior office action replies and also in applicant's original filing (see paragraphs [0004], [0028] and [0029] of applicant's pre-grant publication US

2004/0011695), when using a container for drinking purposes, such a narrowing near the top of the drinking container impedes proper drinking, and the motivation to use the container for drinking thereby teaches away from such a narrowing at the top.

This is strikingly borne out by Allen, which not only does not render applicant's invention obvious in view of Lillelund, but rather supports the view that applicant's invention is not obvious.

Allen is clearly used for drinking beverages. One of Allen's stated purposes, in addition to drinking, is to "resist spillage of the beverage and tipping of the mug" (column 2, lines 29-30). And yet, even despite the stated motivation of Allen to resist tipping and spillage, *Allen does not contain applicant's gradually-narrowing region especially toward the top*. Why? Because such narrowing would make it clumsy to drink

from such a container, as applicant has stated clearly at the time of filing and throughout the prosecution of this case. Because Allen is to be used for drinking, it *omits* the narrowing top region, and by so-doing, provides additional evidence of applicant's oft-stated position that for any container used for drinking, the very motivation to facilitate unimpeded drinking teaches away from a gradually-narrowing top region.

In fact, if one closely examines Figure 3 of Allen, particularly "the mouth portion, generally designated as **12**" (column 3, lines 65-66), it is clear that Allen *actually teaches* a *widening top region*, precisely in accordance with the view that applicant has stated from the outset of this case. It is clear from Figure 3 that the "second end **27** of inner wall **25**" (column 8 lines 57-58) *actually grows wider* when moving upwards along region **14**. This is further evidenced in column 7, lines 20-21 which refer to "an interior shoulder **35**" and column 7, lines 24-27 which state that this "inner wall [**25**] continues upwardly to form an annular sleeve structure **47**, also shown in full in FIG. 3. *This sleeve structure can function as a lip of the beverage mug. . . .*"

This motivates and teaches directly away from applicant's independent claim which specifies "an inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is

smaller than [not larger than as in Allen] said inner mid section diameter," as well as "an inward angle . . . wherein said inward angle is greater than zero degrees [not less than zero degrees as in Allen] at said open top." By teaching a

5 widening opening at the top of the container - which applicant has maintained front the outset is motivated by and typical for a beverage container - *Allen actually supports the view that applicant's device, which has a narrowing opening at the top, is not obvious.*

10 Examiner apparently recognizes this, citing merely that Allen comprises "[a]n inner side surface comprising an inner side section diameter and an inner upper section diameter thereof," while carefully avoiding any reference to the stark fact that applicant's inner side surface gradually narrows at

15 the top while Allen's inner side surface actually widens at the top (to allow unimpeded drinking). With all due respect, given that Allen's the upper region of Allen's inner side surface is configured precisely oppositely to that of applicant's, this is a disingenuous way to cite Allen to facilitate a combination

20 with Lillelund. With its wider top and its clearly disclosed use for drinking, *Allen definitively teaches away from a combination with Lillelund.*

Now, we turn to the base reference Lillelund. Primarily, Lillelund is for a lid for a container, such that the "container

mouth requires no unique structural configuration to accommodate the lid . . .” (column 2, lines 9-12). The only portion of Lillelund which stimulates even the remotest comparison to any aspect of applicant’s invention is the statement in column 5, lines 5-10 that “the mating surfaces of the sealing flange 32 and the container surface 44 inward of the mouth edge 24 may have *frictionally engaging projections or lip-like portions to enhance the seal.*” This is grossly insufficient to support the cited combination with Allen which, as shown above, itself teaches away from any such combination.

Lillelund, first of all, does not in any way discuss avoiding spilling or splashing or tipping, which is a fundamental motivation of applicant’s invention.

Second, to the extent that Lillelund avoids spillage, it is because of the container lid which it discloses - and any collateral splash deterrence which may be inherently-provided by the frictionally engaging projections or lip-like portions - are remote collateral consequences which are not at all part of the motivation or disclosure in Lillelund. That is, not one word of Lillelund is devoted to the matter of avoiding spilling or splashing or tipping. Thus, there is absolutely no teaching or suggestion or motivation to combine Lillelund with Allen in the manner suggested by examiner, “in order to prevent pilling contents in the container.” Examiner himself is supplying this

motivation. It is nowhere to be found in Lillelund. To the extent that examiner reads some implied motivation into Lillelund to avoid spilling or splashing or tipping, Lillelund's lid accomplishes that fully by closing and sealing the container, and so nothing more is necessary.

Third, if Lillelund was motivated to avoid spilling or splashing or tipping, and to do so in the manner invented by applicant rather than in the well-known manner of providing a lid to seal a container, then any person of ordinary skill who is so-motivated would never show, in "FIGS. 1-10, . . . container **20** . . . illustrated as *cylindrical and vertically elongate*," see Lillelund, column 4, lines 5-7. Such a cylindrical and vertically elongate container configuration is well known to be the *least stable and most prone to spilling* of virtually any container configuration imaginable.

Now, to be fair, this entire passage from Lillelund, column 4, lines 4-9, states that "[r]eferring now more specifically to the drawings, and in particular FIGS. 1-10, the container **20** is a typical container which, while illustrated as cylindrical and vertically elongate, can be of other shapes which, in each instance, define an open container mouth 22 having a peripheral planar mouth edge 24." Yet here too, all Lillelund teaches is a "typical" generic container. There is nothing anywhere in Lillelund which suggests that one moment of attention has been devoted to the issue of configuring a container to prevent spilling and splashing and tipping, and so there is simply

nothing in Lillelund that in any way can be said to motivate a combination with Allen. And, Lillelund's choice of a *cylindrical and vertically elongate* container for illustration - while stated to be not limiting - demonstrates that Lillelund, while
5 disclosing this invention, was unconcerned with, never gave any thought to, and was perhaps teaching away from, the proposed combination with Allen. Has there been any concern by Lillelund about spilling and splashing and tipping, Lillelund would never have chosen to use a cylindrical and vertically elongate
10 container for illustration, and / or would have made at least some minimal comment about avoiding spilling and splashing and tipping while the lid was in a state of removal from the container.

Based on the foregoing, there is nothing in either Lillelund
15 or Allen to teach, suggest or motivate their combination, and if anything, each reference teaches away from such a combination.

In applicant's reply to the prior office action, applicant discussed the legal requirements of *KSR v. Teleflex, Inc.* in some detail, and so those discussions will not be repeated here,
20 but are instead hereby incorporated by reference.

Nonetheless, it is important to highlight again here, that In *KSR v. Teleflex, Inc.*, the U.S. Supreme Court clarified that no matter what an examiner's rationale for rejection, it remains "important to identify a reason that would have prompted a
25 person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed.

In the present case, once again, for the reasons set forth above, examiner has failed to identify any such reason. And, for the reasons outlined above, there are good reasons *not* to combine Lillelund and Allen.

5 In this case, there is in fact no teaching, suggestion or motivation to combine the Lillelund and Allen references to arrive at applicant's claimed invention, for the reasons stated above. As stated before, the motivating factors behind the design of a drinking device - which have previously been
10 discussed in the record for this case - are simply not the same as those behind the design of a device for holding surgical fluids such as that which applicant has invented.

Of course, as KSR makes clear, other tests could also be applied to establish a *prima facie* case of obviousness. For
15 example, KSR permit a *prima facie* case to be established by the rationale that it would have been obvious to combine prior art elements according to known methods to yield predictable results. Or, that a claimed invention merely combines prior art elements according to known methods to yield predictable
20 results. Or, that the claimed invention is for a technique for improving a particular class of devices which was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of that technique for improvement in other situations. Or, that a known technique is being applied

to a known device ready for improvement to yield predictable results. Or, that it would have been "obvious to try" applicant's approach by choosing from a finite number of predictable solutions. Or, that a claim would have been obvious because the design incentives or market forces provide a reason to make the adaptation and the invention resulted from application of the prior knowledge in a predictable manner.

Nevertheless, none of these rationales, nor any other rationale, has been cited by examiner to establish a *prima facie* case of obviousness. First, it is examiner's burden to establish such a *prima facie* case which has not been done here, and applicant need not rebut such a rationale nor is it even logically possible to do so, until an examiner has asserted and explained it. Secondly, in applicant's view, were they to be asserted, none of the aforementioned rationales applies to applicant's invention. Therefore, once again, this rejection cannot be sustained under section 103. Third, even if examiner is found to have established a *prima facie* case of obviousness, applicant's arguments above have overcome that *prima facie* case.

Finally, counsel must reiterate and will repeat the more global observation about the invention as claimed in this case and the prior art that has been cited and the attempts which have been made to combine the prior art references, not only in this office action, but in previous office actions.

Applicant's invention, like all inventions, must be taken "as a whole," and cannot not be subjected to "impermissible hindsight." This is still the law in the wake of KSR. Loosely speaking, and referring to Figure 1 of applicant's drawings,

5 applicant's invention combines, into a unitary device, two "halves." First, there is a "top" half characterized by a gradually-narrowing region especially toward the top of the apparatus along the inner surface, which deters spillage when the device is seated on a flat surface (particularly a surgical
10 table), and which, as has been noted in the record before, would prove a rather clumsy structure for any drinking apparatus, especially so given the size of applicant's device, as is specified in dependent claims 12 and 13 (in terms of fluid content) and in dependent claims 15 and 16 (in terms of linear
15 dimensions). Second, there is a "bottom" half characterized by a gradual widening of the base, as one approaches the bottom of the device, which provides stability when the device is resting on a surgical table but when fluid is being extracted therefrom and movement from the fluid extraction can cause the device to
20 tip and spill.

Respectfully, despite a first office action, a first final office action, an office action following an RCE, a final office action following the RCE, and then the new non-final action that it the subject of this reply, and despite the literally millions

of drinking devices and fluid containers that undoubtedly have been designed by humankind over the course of time, examiner has repeatedly failed to find a single example of a drinking device or any other fluid holding device which combines all of the
5 claimed elements of applicant's invention. And, this is indeed a crowded art area in which there are undoubtedly countless devices among which examiner could presumably find such a device if it had been invented heretofore. And, this is not a highly technical or esoteric art area, and so such a device, were it to
10 exist, could have been invented by literally millions if not billions of people. The fact that a device which combines all the features of applicant's invention does not appear to have been invented despite the tremendous opportunity for such a device to have been invented, provides virtually irrefutable
15 evidence that applicant's inventions really is NOT obvious as examiner asserts.

In addition, because the foregoing arguments were already stated clearly and explicitly in the last reply, and because these arguments, as stated by examiner, were "*fully considered*
20 *and are persuasive,*" this present action would have been the opportunity for examiner to uncover and present some prior art reference that combines all of the claimed elements of applicant's invention. Nonetheless, examiner once again - with a clear understanding this argument and *having been persuaded by*

this argument - has continued to fail to find any such prior art.

To continue the analogy used last time, in keeping with the "top" and "bottom" halves as discussed above, there are many types of fish (bottom half) in the world and many type of female human beings (top half) in the world. Applicant has invented what by analogy is a "mermaid" (top and bottom halves all in one), and examiner keeps finding and citing references for numerous types of fish, and for numerous types of female humans, in an effort to assert that it "would have been obvious" for someone to invent a mermaid. Yet, despite countless opportunities over time for a mermaids to have evolved given all the fish and all the female humans existing in the world over centuries of time, such has never happened, and this points strongly away from the asserted obviousness of the combination.

In this action, which is now the fifth office action on the merits in this case, Lillelund, in somewhat of a stretch, is cited as the "female human" (top half) and Allen is cited as the "fish" (bottom half) even though Allen explicitly shows a non-human top half (widening rather than narrowing at the top). This proposed combination is unpersuasive and cannot be legally supported. And examiner has once again failed to produce prior art for a "mermaid," but rather continues to present prior art - separately - for female humans and for fish, and continued to

try to combine these under 35 U.S.C. §103.

In sum, examiner has failed to present any prior art of record to sustain a finding of anticipation or obviousness, and in the current action, once again, has either failed to
5 establish a *prima facie* legal case, of said *prima facie* case, if established, has been overcome.

As such, applicant respectfully request withdrawal of the rejection in this action, and allowance of all claims.

10 Dependent Claims

Replies as regards dependent claims rejections are substantially the same as in the last reply, and are hereby incorporated by reference. None of these dependent claim rejections can be sustained. However:

- 15 3. As regards point 3 of the office action, the containers in Mann cited to reject claims 26 and 29, to the extent that they prevent spilling, do so because they are closed containers just like millions of other closed containers that exist in the world. Mann does not disclose, suggest or motivate any features
20 of these containers which would deter splashes and spills when these containers are opened, i.e., that deter spillage when they have "an open top" as specified in applicant's independent claim
1. As such, this rejection cannot be sustained.

Response to Arguments

4. It is significant, as stated above, that examiner considered applicants' arguments and found them persuasive. Those fundamental arguments have not changed. With all of the
5 innumerable opportunities that billions of people have had over hundreds if not thousands of years to invent a container (which is not high technology) with the structural features of applicant's invention (a "mermaid"), examiner has still not been able to come up with anything more than separate "humans" and
10 separate "fish."

Unless examiner can produce prior art directly anticipating applicant's invention under 35 U.S.C. §102, rather than produce and endless progression of §103 combination of humans and fish without finding a mermaid, the time has arrived following action
15 after action to recognize that the apparatus which applicant has invented in fact does not exist and has not previously been invented despite countless opportunities for it to have been invented. Applicant's invention is not rocket science. Virtually anyone would have the opportunity to invent what
20 applicant has invented, yet nobody ever has, or at least, examiner has not yet shown that anybody has.

Consequently, examiner must recognize that these countless opportunities which have existed for applicant's invention to have been invented before, which never were realized, in and of

themselves demonstrate that applicant's invention is indeed novel and non-obvious and should be granted a patent.

In short, if examiner cannot demonstrate that someone has invented applicant's "mermaid," and can do no better than to
5 keep finding an endless successions of more fish and more humans and keep arguing that humans and fish render mermaids obvious, then applicant is entitled to a patent under U.S. law, and the time has arrived after an unusually large and burdensome number of office actions to now allow this case.

10

Conclusion

As a result of the foregoing, applicant respectfully requests withdrawal of the rejections and allowance of all claims.

15 As noted earlier, if these remarks do not place this application into condition for allowance, applicants' counsel hereby respectfully requests a telephone interview with examiner Kevin Joyner, following receipt of this reply, and prior to issuance of an advisory office action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay R. Yablon". The signature is stylized with a large, looped initial "J" and a cursive "Yablon".

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